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1317

EXAMINER

ART UNIT

PAPER NUMBER

03/28/97
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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES DEPARTMENT OF COMMERCE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Serial Number: 435,072
Filing Date: 05-08-95
Appellant(s): Marc S. Somers

Paper No. 14

Mailed
3-28-97
S.P. 1300

Mark A. Montgomery
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 1-13-97.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-7.

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Claims 8-20 are withdrawn from consideration as not directed to the elected invention.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The brief includes a statement that claims 1-7 do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(5). MPEP § 1206.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,041,251	McCoskey et al	8-1991
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(10) *New Prior Art*

No new prior art has been applied in this examiner's answer.

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(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

This application contains claims 8-20 are drawn to an invention non-elected with traverse in Paper No. 7. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) MPEP 821.01. No cancellation of such claims was made by appellants to date.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by McCoskey et al (5,041,251) including forming particles of particular characteristics (column 2, line 46; column 3, line 61-column 4, line 7; column lines 40-48; column 7, lines 36-44; column 8, lines 29-30); providing an amorphous copolymer at an extrusion die, coextruding said copolymer, contacting the resulting product with a non-sticky polyolefin, cutting the resulting product and coating the product (column 2, lines 27-63, column 4, lines 8-16, column 5, lines 11-13). Also

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see claims 1-21. Concerning claims 1,3-5, the specific types of articles employed in the claimed invention are directed to mere obvious matters of article design/desired choices which are of no patentable consequences to the claimed invention. Additionally, it is submitted that such particular products would have been apparent in the cited reference for reasons therein (see reference). Also, The examiner submits that such material would possess identical viscosity as claimed as such property would be inherent. It is further submitted that such limitations are directed to the particular exposed surface area of the resulting product which are expressly drawn to article limitations and not believed germane in the instant question for patentability. Concerning claims 2 and 6, the cited reference teaches similar non-sticky material in column 5, lines 31-33. Concerning claim 7, the cited reference teaches similarly claimed steps in column 3, lines 11-21.

Appellant's arguments filed 3-25-96 have been fully considered but they are not deemed to be persuasive. Appellant argue that 1) although the cited reference may disclose similar steps, the steps are not the same or in the same order as required in the claimed invention. The examiner would disagree because it is believed that McCoskey et al patent indeed teaches the identical steps and the respective step sequence as claimed and the appellant has failed to expressly show how the claimed

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steps differ from that of the cited reference. Appellant argue that 2) the claimed invention requires the co-extrusion of an amorphous propylene copolymer in a sheath of a non-tacky polyolefin and points to portions of the submitted specification to support this argument. The examiner would respond by reminding applicant that such article structural limitations were not claimed. Although such product limitations can be found as examples or embodiments in the specification, it was not explicitly claimed. Nor were such words used in the claims defined in the specification requiring these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to the disputed terms. *Constant V. Advanced Micro-Devices Inc.*, 7 USPQ 2d 1064. The examiner's intent was not to reject portions of the specification but instead reject the claims, if applicable, as submitted for examination. In conclusion, it appears that the applicant is arguing that the submitted claims should be allowed, i.e., presenting conclusion, but fails to show how such claims differ from the teachings and/or suggestions of the cited McCoskey et al patent (i.e., fails to provide evidence to that effect). 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does

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not comply with the requirements of this section". Appellant has failed to specifically point out how the language of the claims patentably distinguishes them from the references.

THIS ACTION WAS MADE FINAL. Appellant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

(12) New Ground of Rejection

This examiner's answer does not contain any new ground of rejection.

(13) Response to argument

Appellant argues that 1) the McCoskey et al patent makes a desirable product that has proven to be an expensive process, while the present claimed invention is an improvement thereover. In effect, appellant contends that all the steps are not the same

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as those claimed. First, the examiner wishes to respectfully remind appellant that the office is in no position to determine experimentally whether or not, in a process such as that at issue, the subject matter contended is the same as that contended against the prior art. Accordingly, in such instances, this shifts the burden to the appellants who have the resources to make a clear distinction and to better experimentally define and identify the differences between the obvious teachings of the reference and the claimed invention. Appellant argues that 2) both contents and sheath are formed from the molten state, one inside the other, as both material exit the die. To this the examiner would direct appellants to column 4, lines 26-39 for specific teachings directed to molten extrusion of both material and also ,column 6, lines 39-48 is cited for teachings showing that the polymers are at or above the polymers ring and ball softening points.


Appellant finally argues 3) that although the limitations are not claimed, one of ordinary skill in the art would interpret the claims as argued . The examiner would respond by reminding appellant that it is incumbent on all applicants to expressly and explicitly claim their respective inventions to expedite the examination of the respective applications.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

M. Dixon:jp
March 11, 1997

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